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09/828,938	04/10/2001	Tomoko Terakado	205602US6DIV	8040

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EXAMINER

SAJOUS, WESNER

ART UNIT	PAPER NUMBER
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2676

DATE MAILED: 04/28/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

10

# Office Action Summary

Application No.

09/828,938

Applicant(s)

TERAKADO ET AL.

Examiner

Wesner Sajous

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-13,20-27,31,33-48,52-61,65-76 and 81-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-13,20-27,31, 33-48,52-61,65-76 and 81-88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Remarks**

This communication is responsive to the amendment and response filed on February 20, 2003. Claims 3, 28-29, 49-51, 62-64, and 77-80 are canceled. Claim 1 is amended. Accordingly, claims 1-2, 4-13, 20-27, 31, 33-48, 52-61, 65-76, and 81-88 are currently pending in the application.

### **Response to Arguments**

1. With respect to the obviousness type double patenting rejections, it is noted that these rejections are obviated by the Applicants claims' cancellation, amendment and arguments. Accordingly, the double patenting rejections are withdrawn.

All other arguments with respect to prior art rejections are moot in view of the new ground of rejections.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1-2, 4-13, 20-23, 25-26, 31, 75-77, 80-81, and 84-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee et al. (Darbee), Pat. No. 6130726, in view of Jones, Pat. No. 5978013.

Considering claim 1, Darbee, at figs. 1-2, discloses a control device (10) which controls, by transmitting a control signal (*e.g.*, a *IR or RF transmitter*, see *abstract*), an electric apparatus (*e.g.*, a *consumer electronic device or a TV set*, see *abstract*) that receives information transmitted via a transmission medium (*e.g.*, a *conventional IR transmitter of a TV set that operates in conjunction with a remote control*, see *col. 4, lines 20-25*) comprising a transmitting unit (35) for transmitting the control signal to the electric apparatus; a receiver (34) for receiving additional information (*e.g.*, *advertising or program guide*, *col. 4, lines 33-36*) that has been extracted from the received information and transmitted by the electric apparatus (*e.g.*, the TV set); an output means (*e.g.*, *items 18, or 20 or 22 or 24 or 25 of fig. 6 and/or fig. 2, items 38 and 28*) for outputting the additional information received by the receiver to a display device (14); a memory (*e.g.*, *item 36 or 40*) for storing at least a portion of said additional information (*e.g.*, *detail information about the current program on the channel {cols. 9-10, lines 65-2}, or detail view information about a movie {col. 14, lines 51-61}*).

It is noted that Darbee fails to teach the erasing unit for deleting the information stored in the memory.

However, Jones, in the same field of endeavor, teaches an erasing unit (98) for deleting the information stored in the memory (see *col. 10, lines 7-30*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the control device (10) of Darbee to include the erasing

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unit as taught by Jones; in order to remove unnecessary data from the memory and create more store space for additional information favored by the user.

Re claim 2, Darbee discloses additional information is an EPG that is included in the information received by the electric apparatus. See abstract, and col. 4, lines 33-40.

Re claim 4, the claimed "selecting unit for selecting ... information received by the receiver, wherein said memory is configured to store the information selected by the selecting unit" is met by the functions performed by item 28 of fig. 2 in Darbee's.

As per claim 5, (a) the claimed "second storing unit for storing the additional information..." is met by Darbee's fig.2, items 42.

In claim 6, the claimed "notifying unit for notifying a user of reception of the additional information when the receiving means receives automatically receives the additional information" is met by Darbee's item 14 of fig. 1.

The invention of claim 7 substantially recites the underlying elements of claim 1. As the various elements of claim 1 have been shown to be rendered obvious over the combined teachings of Darbee and Jones, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 7 are rejected for the same rationale set forth for claim 1.

The invention of claim 8 substantially recites the underlying elements as performed by method claim 7. As the various elements of claim 7 have been shown to be rendered obvious over the combined teachings of Darbee and Jones, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 8 are rejected by the same rationale set forth for claim 7, for in the Darbee's's disclosure, a computer program or software incorporated in devices 28 and 36 is implemented for performing the invention.

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The invention of claim 9, including the limitations of: storing a computer program transmitted from the transmission medium...; and performing a control by using the computer program (as met by devices 16-18 and 20-21), substantially recites the underlying elements as performed by method claim 8. As the various elements of claim 8 have been shown to be anticipated by the teachings of Knee, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 8 are rejected by the same rationale set forth for claim 8, for in the Knee's disclosure, a computer program or software incorporated in device 16 is implemented for performing the invention.

Regarding claim 10, Darbee discloses an electric apparatus (*e.g., a consumer electronic device or a TV set, see abstract*) which receives information that is transmitted via a transmission medium (*e.g., an antenna or a satellite*) and performs an operation in accordance with a control signal that is transmitted from a control device (10). It is noted that the television set in Darbee is provided with a bi-directional communication capability with the remote control (see col. 2, lines 52-53, and col. 4, lines 19-40. Thus, all the elements recited in claim 10, including the first receiving unit (*e.g., an IR receiver*) for receiving the control signal transmitted from a control device (10); a controller (*e.g., a well known microcontroller or CPU*) for performing a control in accordance with the control signal received by the first receiving (*e.g., an IR receiver integral in the television set*); a second receiving unit (*e.g., a well known television tuner or*) for receiving the information transmitted via the transmission medium; an extracting unit (*e.g., a well known microcontroller or CPU*) for extracting additional information from the information received by the second receiving means; a transmitting unit (*e.g., a well know RF transmitter integral in the TV set*) for transmitting the additional extracted by the extracting means to the control device; wherein the control device (10)

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is configured to store (via item 36) said extracting additional information (e.g., advertisement or program guide information, see col. 4, lines 33-36), although they are not shown, they are noted to be well known components included in a conventional television set. These components could facilitate the applied set-top box or television set in Darbee to communicate information to and from the remote controller 10.

It is noted that Darbee fails to teach the erasing unit for deleting the information stored in the memory, and that the addition information includes coupon information.

However, Jones, in the same field of endeavor, teaches additional information includes coupon information (see col. 4, lines 60 to col. 5, line 8), and the erasing unit (98) for deleting the information stored in the memory (see col. 10, lines 7-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the control device (10) of Darbee to include the coupon information and the erasing unit as taught by Jones; in order to remove unnecessary data from the memory and create more store space for additional information favored by the user.

The invention of claim 11 recites features equivalent to and performing the same functions as apparatus claim 10 and is similarly rejected.

The invention of claim 12 substantially recites the underlying elements as performed by method claim 11. As the various elements of claim 11 have been shown to be rendered obvious over the combined teachings of Darbee and Jones, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 12 are rejected under the

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same rationale set forth for claim 11, for in the Darbee, a computer program or software incorporated in devices 28 and 36 are implemented for performing the invention.

The invention of claim 13, including the limitations of: storing the computer program (e.g., via item 36) transmitted from the transmission medium (35); and controlling the electric apparatus (e.g., a consumer electronic device or TV [not shown]) by using the computer program (incorporate in items 28 and 36), substantially recites the underlying elements as performed by method claim 12. As the various elements of claim 12 have been shown to be rendered obvious over the combined teachings of Darbee and Jones, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 12 are rejected under the same rationale set forth for claim 12, for in the Darbee's disclosure, a computer program or software could be incorporated in devices 28 and 36 and/or in the well known microcontroller and ROM integral in the television set for performing the invention.

In claim 20, the claimed "control device instructs the electric apparatus to transmit the additional information" is by the function of item 28 of fig. 2.

In claim 21, the claimed "notifying means for notifying a user of reception of the additional information when the receiving means receives automatically receives the additional information" is met by Darbee's item 14 of fig. 1.

In claim 22, the claimed "electric apparatus is a personal computer" is met by Darbee at col. 4, lines 50-56.

Re claim 23, the claimed "electric apparatus is a television receiver" is met by Darbee at col. 4, lines 50-56.

As per claims 25-26, the claimed "output means outputs that part of the additional information which relates to a channel of current reception of the electric



apparatus and which relates to information that will be received by the electric apparatus from a present time onward" would have obvious the system of Darbee, since it enables the user to view program guide, identifying PPV information (see fig. 12) select information pertaining to specific genres or categories (see fig. 32) and to retrieve the selected category (see col. 6, lines 38-41) transmitted from the television set. The information when requested, are outputted in display 14 of the remote control. See col. 2, lines 2, lines 6-67, col. 3, line 31 to col. 4, line 5, and col. 9, lines 58-65.

Re claim 31, Darbee discloses the equivalence for the electric apparatus is a personal computer that accesses a server based on information transmitted from the remote control. See col. 4, lines 20-32, and 55-56. The applicant should duly note that since the system' computer can access the Internet via a modem based on instruction from the remote controller 10, it is apparent that the downloaded information can be accessed via a server.

The invention of claim 75 substantially recites the underlying elements as performed by claim 1. As the various elements of claim 1 have been shown to be rendered obvious over the combined teachings of Darbee and Jones, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 75 are rejected for the same rationale set forth for claim 1.

Claims 76-77 are rejected for the same reasons as claims 2 and 3 respectively.

In claim 80, the claimed additional information ... advertisement information is stored in a prescribed area at said storing step" would have been obvious over the functionality of the remote controller 10 in Darbee, for device 10 includes a memory 36 coupled to controller 28, that upon receiving an instruction from the user may used to store such an additional information as desired by the user.

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Claims 81, 84-88, respectively, are rejected for the same reasons as claims 5, 6, and 20-21, and 25-26, respectively.

4. Claims 24, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee in view of Jones and further in view of Takahashi and further in view of Hirose.

Considering claims 24, and 27, Darbee, and Jones render obvious most claimed features of the invention but they fail to suggest that the second electronic apparatus is a recording apparatus performing recording reservation or a computer accesses a server based on the information transmitted from the control device.

Nonetheless, Hirose at fig. 1 illustrates a recording medium 7 as one of a plurality of electronic devices receiving information transmitted from a broadcasting station. Such recording medium is shown interfacing with a receiver. Such receiver is noted to be capable of receiving cable television broadcasting which could be used with a remote controller for transmitting signal to the receiver. Hirose also shows that a personal computer may be used to receive the information via a local area network. It is to be appreciated that computer, by means of the LAN, is able to access a server as is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings suggested by Darbee and Takahashi and to incorporate their features with Hirose, in order to enhance the flexibility of the system.

5. Claims 33-37, 39, 41-48, 52, 54-61, 67, 69, 70-74 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee in view of Takahashi (or in view of Nishizawa et al.).

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Considering claim 33, Darbee, at figs. 1-2, discloses a control device (10) which controls, by transmitting a control signal (e.g., a *IR or RF transmitter, see abstract*), an electric apparatus (e.g., a *consumer electronic device or a TV set, see abstract*) that receives information transmitted via a transmission medium (e.g., a *conventional IR transmitter of a TV set that operates in conjunction with a remote control, see col. 4, lines 20-25*) comprising a transmitting unit (35) for transmitting the control signal to the electric apparatus; a receiver (34) for receiving additional information (e.g., *advertising or program guide, col. 4, lines 33-36*) that has been extracted from the received information and transmitted by the electric apparatus (e.g., the TV set); an output means (e.g., *items 18, or 20 or 22 or 24 or 25 of fig. 6 and/or fig. 2, items 38 and 28*) for outputting the additional information received by the receiver to a display device (14); selecting means (e.g., by pressing any key of the remote control 10) for selecting information from the additional information received by the receiving means.

Darbee fails to teach an IC card as a detachable storing means for storing information selected by the selecting means (31).

However, Takahashi, in the same field of endeavor, discloses an IC card (item 41 of fig. 8). Note that the IC card 41 provided in Takahashi is a semiconductor memory, and such can be detachably attachable to and from the receiver 5 (as is well known in the art, see patent no. 5805214 assigned to Nishizawa et al.) or to the remote controller 6 for flexible operation, and/or for allowing the user to easily access information communicated to the receiver. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the IC card disclosed in Takahashi together with the control system described in Knee, in order to limit the amount of time it takes a user to retrieve his or her favorite program information stored in the storing means. See (col. 2, lines 5-15).

Re claim 34, Darbee discloses the additional information is an EPG that is included in the information received by the electric apparatus. See abstract, and col. 4, lines 33-40.

In claim 35, the claimed "additional information is advertising information EPG that is included in the information received by the electric apparatus" is met by col. 4, lines 33-40.

Re claim 36, the claimed "advertisement information includes coupon information" is met by Darbee's col. 3, line 25.

In **claim 37**, the claimed "advertisement information includes URL information" is met in Darbee's col. 8, lines 5-10.

As per claim 39, the claimed "second storing unit for storing the additional information..." is met by Darbee's fig.2, items 42.

Re claim 41, Darbee discloses the equivalence for the electric apparatus is a personal computer that accesses a server based on information transmitted from the remote control. See col. 4, lines 20-32, and 55-56. The applicant should duly note that since the system' computer can link the Internet based on instruction from the remote controller 10, it is apparent that the downloaded information can be accessed via a server.

In claim 42, the claimed "notifying unit for notifying a user of reception of the additional information when the receiving means receives automatically receives the additional information" is met by Darbee's item 14 of fig. 1.

In claim 43, Darbee discloses control device (10) instructs the electric apparatus to transmit the additional information.

In claim 44, the claimed "notifying means for notifying a user of reception of the additional information when the receiving means receives automatically receives the additional information" is equivalently met by the function of display 14.

As per claim 45, the claimed "output means outputs that part of the additional information which relates to a channel of current reception of the electric apparatus" is met by fig. 2, item 14.

As per claim 46, the claimed "output means outputs that part of the additional information which relates to information that will be received by the electric apparatus from a present time onward" is equivalently met by the function of display 14 in Darbee.

The invention claim 47 substantially recites the underlying elements as performed by claim 46. As the various elements of claim 46 have been shown to be rendered obvious over the combined teachings of Darbee and Takahashi, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 47 are rejected under the same rationale set forth for claim 46.

Re claim 48, the claimed "additional information is an EPG that is included in the information received by the electric apparatus" see abstract.

Claim 52 is rejected for the same reason as claim 39.

Claim 55 is rejected for the same reason as claim 42.

Claim 56 is rejected for the same reason as claim 43.

Claims 54, 69, and 83 recite features similar to claim 31; they are, therefore, rejected under the same rationale.

Claims 57-59 are rejected for the same reason as claims 44-46, respectively.

The invention of claim 60 recites features equivalent to and performing the same functions as claim 47, and is, therefore, subject to rejections for the same reasons and rationale set forth for claim 47.

Claim 61 is rejected for reasons similar to claim 48. information is stored in a prescribed area at said storing step" is equivalently met by devices 16—18 or 20 of fig. 1 in Knee.

Claims 67, 70-74 recite features similar to and performing the same functions as in claims 52, 55-59 respectively, and they are similarly rejected.

6. Claims 38 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee in view of Takahashi and further in view of Jones

Darbee fails to teach the erasing unit for deleting the information stored in the memory.

However, Jones, in the same field of endeavor, teaches the erasing unit (98) for deleting the information stored in the memory (see col. 10, lines 7-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the control device (10) of Darbee to include the coupon information and the erasing unit as taught by Jones; in order to remove unnecessary data from the memory and create more store space for additional information favored by the user.

Claim 65 is rejected for reason similar to claim 38.

**Conclusion**

7. The prior art made of record and considered pertinent to applicant's disclosure are as recited in the PTO-892 Form.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
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**or faxed to:**

(703) 872-9314, (for Technology Center 2600 only)

**Or:**

(703) 308-5359 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121  
Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesner Sajous whose telephone number is (703) 308-5857. The examiner can also be reached on Mondays thru Thursdays and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella, can be reached at (703) 308-6829. The fax phone number for this group is (703) 308-6606.

**Wesner Sajous -WS-**

11/16/02

